

ESTTA Tracking number: **ESTTA563631**Filing date: **10/07/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Turner Entertainment Co.
Granted to Date of previous extension	10/06/2013
Address	4000 Warner Boulevard Burbank, CA 91522 UNITED STATES

Attorney information	Avis Frazier-Thomas Warner Bros. Entertainment Inc. 4000 Warner Blvd., Bldg. 156-N. Burbank, CA 91522 UNITED STATES Maripaz.Rodriguez@warnerbros.com
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Applicant Information

Application No	85453715	Publication date	04/09/2013
Opposition Filing Date	10/07/2013	Opposition Period Ends	10/06/2013
Applicant	Disney Enterprises, Inc. 500 South Buena Vista Street Burbank, CA 91521 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, aprons, beachwear, bottoms, chaps, cloaks, cloth bibs, coats, Halloween costumes, costumes for use in children's dress-up play, beach cover-ups, cummerbunds, dresses, ear muffs, gowns, gloves, hosiery, infantwear, jackets, leotards, lingerie, loungewear, mittens, overalls, pants, ponchos, rainwear, scarves, shirts, shorts, skirts, sleepwear, socks, suits, sweaters, sweatshirts, swimwear, ties, tops, underwear; belts; footwear; headwear; wrist bands

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1925552	Application Date	05/25/1994
Registration Date	10/10/1995	Foreign Priority Date	NONE

Word Mark	WIZARD OF OZ
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1986/03/01 First Use In Commerce: 1986/03/01 clothing, namely ties, gloves, boxer shorts, underwear, shirts, T-shirts, sweatshirts, tops, sweaters, jackets, sweatpants, shorts, play suits, swimwear, hats, visors, caps, socks, shoes and slippers

Attachments	uspto 85453715.pdf(55568 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Avis Frazier-Thomas/
Name	Avis Frazier-Thomas
Date	10/07/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application No. 85453715 for the mark OZ THE GREAT AND POWERFUL filed on October 21, 2011,
and published on April 9, 2013

TURNER ENTERTAINMENT CO. :

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Opposer :

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v. : Opp. No. _____

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DISNEY ENTERPRISES, INC. :

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Applicant :

NOTICE OF OPPOSITION

Turner Entertainment Co. believes that it will be damaged by the registration of the above identified mark and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, it is alleged that:

1. Opposer is the owner of all right, title and interest in and to a family of marks containing the word OZ, including WIZARD OF OZ and THE GREAT AND POWERFUL OZ (collectively, "Opposer's Marks"), which marks have been used for a wide variety of goods and services, including various goods in Class 25.
2. Opposer's marks are derived from the famous movie The Wizard of Oz (Opposer's Movie"), which was released in 1939 and is now regarded as one of the most famous movies ever made.
3. Since long prior to the acts complained of in this notice, Opposer's Marks have been used extensively in connection with a highly successful worldwide trademark licensing program.
4. The Patent and Trademark Office has recognized Opposer's exclusive right to use Opposer's Mark by issuing the following registrations:

Reg. No. 1,925,552 WIZARD OF OZ issued on October 10, 1995.

Reg. No. 1,914,813 WIZARD OF OZ issued on August 29, 1995.

Reg. No. 2,298,902 WIZARD OF OZ issued on December 7, 1999.

Reg. No. 2,298,903 WIZARD OF OZ issued on December 7, 1999

Reg. No. 2,547,649 WIZARD OF OZ issued on March 12, 2002.

Reg. No. 2,700,697 WIZARD OF OZ issued on March 25, 2003.

Reg. No. 3781620, THE WIZARD OF OZ issued April 27, 2010

And Applicant owns several pending applications for other OZ marks, including

Appln No. 85349667, THE GREAT AND POWERFUL OZ, filed June 17, 2011

Appln No. 85459439, THE GREAT AND POWERFUL OZ, filed October 28, 2011

5. The registrations are valid and subsisting, and most of them are incontestable. Accordingly, they provide prima facie and conclusive evidence of Opposer's ownership of Opposer's Marks and of its exclusive right to use the marks in commerce.

6. Although Opposer's movie The Wizard of Oz is based on the book, The Wonderful Wizard of Oz, Turner and its predecessors were the first to acquire trademark rights in the names of characters, places and things identified in the book and the movie by actually using and licensing others to use these marks in connection with a wide variety of goods and services.

7. Turner has developed a large network of licensees that have sold a wide variety of products under Turner's family of Oz Marks.

8. Opposer's Wizard of Oz movie is one of the most beloved and well-known movies ever made as evidenced by the fact that it is ranked No. 6 on the American Film Institute's 1997 and 2007 lists of the 100 Greatest Movies of All Time.

9. The Library of Congress has recognized that Turner's movie, The Wizard of Oz is the Most Watched Movie of all Time.

10. The film was nominated for Best Picture by the Academy of Motion Picture Arts and Science and won Oscars for Best Original Score and Best Song "Over the Rainbow."

11. Opposer's Marks have been widely used and publicized for many years, through annual television broadcasts of the famous motion picture entitled The Wizard of Oz, and in many other ways including the sale of videos, DVDs, and other goods and services, the broadcast of the motion picture on the Turner Classic Movie Channel, and through various websites including Petitioner's site at www.tcm.com and the website of its related company Warner Bros. at <http://www.wbshop.com/Wizard-of-Oz/wiz,default,sc.html> .

12. As a result Opposer's Marks have become well known and famous as distinctive indicators of the origin of Opposer's goods and services.

13. Notwithstanding Opposer's prior established rights in its Marks, Applicant filed an intent to use application seeking registration of the mark, OZ THE GREAT AND POWERFUL for various goods in Class 25 including

Clothing, namely, aprons, beachwear, bottoms, chaps, cloaks, cloth bibs, coats, Halloween costumes, costumes for use in children's dress-up play, beach cover-ups, cummerbunds, dresses, ear muffs, gowns, gloves, hosiery, infantwear, jackets, leotards, lingerie, loungewear, mittens, overalls, pants, ponchos, rainwear, scarves, shirts, shorts, skirts, sleepwear, socks, suits, sweaters, sweatshirts, swimwear, ties, tops, underwear; belts; footwear; headwear; wrist bands.

14. Applicant's alleged mark was copied directly from Opposer's Movie and the phrase OZ THE GREAT AND POWERFUL is not found in the book on which Opposer's Movie was based.

15. Upon information and belief, Applicant made no use of its alleged mark in commerce prior to the filing date of its application.

16. Opposer's Marks have been used continuously on or in connection with its goods in interstate commerce since long prior to the filing date of Applicant's application or any first use date that Applicant may claim.

Likelihood of Confusion - §2(d)

17. The mark that Applicant seeks to register is identical to or so resembles Opposer's name and mark that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant's goods and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's Marks.

18. The goods of Applicant are so related to the goods sold under Opposer's Mark that the public is likely to be confused, to be deceived and to assume erroneously that Applicant's goods are those of Opposer or that Applicant is in some way connected with, licensed or sponsored by, or affiliated with Opposer.

19. Likelihood of confusion in this case is enhanced by the fame of Opposer's Marks and by the fact that consumers associate said marks with services and goods sold, approved or endorsed by Opposer.

20. Likelihood of confusion is enhanced in this case by the fact prospective purchasers of Applicant's products also are prospective purchasers of products sold under Opposer's Marks.

21. Likelihood of confusion may be presumed in this case because Applicant adopted an imitation of Opposer's Marks in bad faith with an intent to cause confusion, and with an intent to capitalize on the popularity of Opposer's Marks.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

TURNER ENTERTAINMENT CO.

By: / AVIS FRAZIER-THOMAS/

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